

Application No.: 10/604,276  
Amendment dated: June 5, 2007  
Reply to Office Action of February 5, 2007  
Attorney Docket No.: 21295-61

### REMARKS/ARGUMENTS

Claims 1-12 are pending in this application. Claims 1-12 were rejected.

Claims 1, 2, 6, 8, and 12 have been amended as indicated hereinabove.

Claim 12 was rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant believes that amended Claim 12 traverses this rejection.

Claims 1-9, 11, and 12 were rejected under 35 U.S.C. 102(b) as being anticipated by Ellings (5,077,473). This rejection is respectfully traversed for the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found in a single cited publication. *Verdegual Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Ellings analyses data captured by a scanning microscope, calculates supplemental signals defining supplemental motion in two dimensions, and adds these supplemental signals to signals driving scanners of the scanning microscope in two dimensions, in particular, to compensate for drift. See Figs. 2 and 3.

The present invention does not modify signals driving any scanners; in fact, the microscope used to practice the invention does not have to be a scanning microscope (see paragraph [0025]). Control variables determined by analyzing an image or images are delivered in the present invention to non-scanning actuators. The actuators are used in the present invention, for example, to change the intensity of the illuminating light, to change the gain of the photomultiplier of a detector unit, etc. (see paragraph [0030]).

The amended Claim 1 comprises transferring the control variable to at least one non-scanning actuator of the microscope, the control variable being determined by analyzing an image or images. This element is not found in Ellings.

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The same argument applies to Claims 2-9, 11, and 12.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elings in view of Tsuneta (6,570,156). This rejection is respectfully traversed for the following reasons.

To establish *prima facie* obviousness of a claimed invention, all the claim elements and limitations must be taught or suggested by the cited publications. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).


Dependent Claim 10 depends on amended independent Claim 6. As argued above, amended Claim 6 comprises transferring a control variable to at least one non-scanning actuator of the microscope, the control variable being determined by analyzing an image or images. This element is not taught or suggested by Ellings or Tsuneta.

It is believed that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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